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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,497	07/02/2003	Tienteh Chen	200309844-1	9905
22879	7590	11/17/2008	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				SHEWAREGED, BETELHEM
ART UNIT		PAPER NUMBER		
1794				
			NOTIFICATION DATE	DELIVERY MODE
			11/17/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,497	CHEN, TIENTEH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Betelhem Shewareged	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 August 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. Applicant's response filed on 08/01/2008 has been fully considered. Claims 11-20 are canceled, and claims 1-10 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sismondi et al. (US 6,387,473 B1) in view of Miller (US 2002/0142141 A1).

4. Sismondi teaches an ink jet receiving sheet comprising a support and ink receiving layers on the support (abstract). The support is described on col. 4, line 30. The ink receiving layers comprise a non-ionic surfactant (col. 3, line 31 thru col. 4, line 29), a binder (col. 5, line 63 thru col. 6, line 48), inorganic particles (col. 7, line 11 thru col. 24), an additional surfactant (col. 7, line 43 thru col. 61), a mordant (col. 7, line 62 thru col. 8, line 61), and a hardener (col. 8, line 63 thru col. 9, line 17). The additional surfactant meets the claimed nonsiloxane surfactant. With respect to claims 8-10, the ink receiving layers further comprise glossiness improving agents, matting agents, a plasticizer, biocides and conventional additives; however, these additional components are added to improve the pictorial or physical properties of the image.

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5. Sismondi does not teach the use of silicone surfactant as the non-ionic siloxane surfactant. However, Miller teaches an image receptor sheet comprising an image receiving layer provided on a substrate, wherein the image receiving layer comprises a non-ionic silicone surfactant such as SILWET L-7605 [0049]. Since the SILWET L-7605 of Miller is substantially identical to Applicant's non-ionic silicone surfactant, current claims 2-5 and 7 are taught by the reference of Miller. Sismondi and Miller are analogous art because they are from the same field of endeavor that is the ink jet recording sheet art. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the silicone surfactant of Miller with the invention Sismondi, and the motivation would be, as Miller suggests, improving handling and sheet feeding characteristics [0049].

6. The surfactant of Miller, among other components, is mixed with at least one organic polymer, and then the mixture is coated followed by drying to form the layer (Examples). Upon drying there must be some type of bonding among the components, otherwise the coated layer would fall off.

7. The relative amount of the nonionic siloxane surfactant and the nonsiloxane surfactant are not taught by the reference(s). The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the relative amount of the nonionic siloxane surfactant and the nonsiloxane surfactant, and the motivation would be to control surface tension, wetting properties and glossiness of the layer. A prima

facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

### ***Response to Arguments***

8. Applicant's argument is based on that, if the person of ordinary skill in the art were to combine the non-ionic surfactant of *Sismondi* (col. 3, line 31 - col. 4, line 29) with an additional surfactant in the form of the siloxane surfactant disclosed by *Miller* [0049] in formulating the outermost layer of *Sismondi*, there would have been no reasonable expectation of success in achieving exactly the same composition as defined by any of claims 1-10. This argument is not persuasive for the following reason. The Examiner did not try to replace the "additional surfactant" of *Sismondi* (col. 7, lines 43-61) with the siloxane surfactant of *Miller* [0049], instead the "non-ionic surfactant" of *Sismondi* (col. 3, line 31 thru col. 4, line 29) was replaced with the siloxane surfactant of *Miller*. The combination of *Sismondi* and *Miller* teaches the use of both non-ionic siloxane and non-siloxane surfactants. The Examiner further showed that the relative amount of the non-ionic siloxane surfactant and the non-siloxane surfactant is optimizable in the absence of unexpected results. The specification of the current application does not show the criticality of the relative amount of the non-ionic siloxane surfactant and the non-siloxane surfactant. The current examples show that a superior image quality can be achieved by using non-ionic siloxane surfactant as oppose to using non-siloxane surfactant. However, the examples do not show the criticality of

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using both the non-ionic siloxane and the non-siloxane surfactants where the non-ionic siloxane is in a grater amount.

9. For the above reason claims 1-10 stand rejected.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

November 8, 2008.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1794